

### **REMARKS**

The present Office Action addresses and rejects claims 1-7 and 28. Applicants respectfully request reconsideration in view of the amendments and remarks herein.

#### ***Amendments to the Claims***

Applicants amend independent claim 1 to include limitations previously set forth in claim 3. Applicants amend independent claim 28 to include limitations previously set forth in claim 2. No new matter is added.

#### ***Rejections Pursuant to 35 U.S.C. § 102***

Claims 1 is rejected pursuant to 35 U.S.C. § 102(b) as being anticipated over U.S. Patent No. 5,346,497 of Simon. As noted above, claim 1 is amended to include limitations previously set forth in claim 3, thereby obviating the basis for this rejection.

#### ***Rejections Pursuant to 35 U.S.C. § 103 over Simon in view of Stavropoulos***

Claims 2, 6, and 28 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Simon in view of U.S. Patent No. 4,142,517 of Stavropoulos. As noted above, claim 1 is amended to include the limitations of claim 3, thereby obviating the basis for this rejection with respect to claims 2 and 6, which depend from claim 1.

Claim 28 as amended recites an apparatus for harvesting bone plugs having a plurality of markings on an outer surface thereof for indicating an insertion depth of a sheath into bone. The Examiner admits that Simon fails to teach an apparatus having markings thereon and thus relies on Stavropoulos to teach the recited markings to “allow a measurement of and a limit to the depth of insertion of the tube within a patient’s body.”

At the outset, no person having ordinary skill in the art would modify Simon to include markings because such a modification would be useless and would not provide any advantage or beneficial result. Simon teaches cutting heads for use in performing cataract surgery. Cataract

surgery is a procedure requiring the cutting of surface tissue on the eye and is therefore a procedure in which the entire device, including the cutting heads, remains outside of the body and on the surface of the eye. Stavropoulos, on the other hand, is directed toward harvesting bone marrow, a procedure which requires inserting a device into a patient's body. Stavropoulos thus requires measurement markings associated with the device so that the depth of insertion can be monitored during the procedure. Adding markings to the cutting heads of Simon would provide no advantage or beneficial result because Simon does not require that any depth be measured or monitored since the surgical procedure remains on the surface of the eye. Accordingly, combining Simon with Stavropoulos provides no reasonable expectation of success of beneficial result, and therefore is not obvious.

***Rejections Pursuant to 35 U.S.C. § 103 over Simon in view of Hallac***

Claims 3-5 are rejected pursuant to 35 U.S.C. 103(a) as being obvious over Simon in view of U.S. Patent No. 3,605,721 of Hallac. As noted above, independent claim 1 as amended includes limitations recited in claim 3. Accordingly, claim 1 will be addressed in response to this rejection.

Claim 1 requires an apparatus for harvesting bone plugs having at least one recess spaced apart from a distal end of the tube. As indicated by the Examiner, Simon does not teach a recess spaced apart from the distal end. Instead, the recess of Simon extends through the distal end. The Examiner thus relies on Hallac to teach such a recess. As shown in FIG. 1, Hallac discloses a biopsy needle having a weakened wall portion adapted to collapse upon rotational movement to collect a tissue sample. Because the recesses disclosed in Hallac are specifically designed to weaken the needle to allow it to collapse, no person having ordinary skill in the art would modify Simon to include this feature. In fact, combining the weakened and collapsible wall section of Hallac with the cutting heads of Simon would prove extremely detrimental to the cutting heads of Simon during cataract surgery. As described above, the cutting heads of Simon are designed for use in cutting delicate surface tissue of the eye. Weakening sidewalls of the cutting heads of Simon by removing a portion of the sidewall as described in Hallac would endanger the stability and rigidity of the cutting heads, causing them to break or collapse during surgery, thereby rendering the device of Simon unusable and potentially dangerous to a patient. Accordingly, claim 1 as well as claims 3-

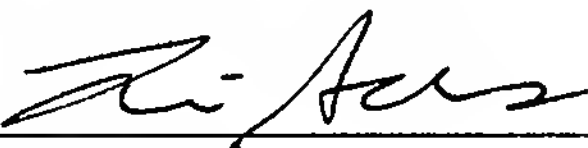
5 which depend therefrom, distinguish over Simon in view of Hallac and represent allowable subject matter.

### ***Conclusion***

Applicants submit that all claims are in condition for allowance, and allowance thereof is respectfully requested. Amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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